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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Judith ARONHIME et al.

Serial No. : 10/074,181

Filing Date : February 12, 2002

For: NEW CRYSTAL FORMS OF OXCARBAZEPINE AND  
PROCESSES FOR THEIR PREPARATION

Examiner : Pulliam, Amy

Art Unit : 1615

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date: OCT 9, 03 Reg. No. 32,048

Signature: Payam Moradian  
Payam Moradian**ELECTION AND RESPONSE TO RESTRICTION  
REQUIREMENT UNDER 37 CFR §§ 1.111 AND 1.143**

This Amendment under 37 C.F.R. §§ 1.111 and 1.143, addresses the Office  
Action dated July 1, 2003.

**REMARKS**

Applicants were required to elect one of the following groups of  
invention:

- I. Claims 1-4, 7, 11-15, 20-23, 32-37, 45, and 68-72 drawn to oxcarbazepine and its methods of use, classified in class 514, subclass 217.
- II. Claims 5, 6, 8-10, 16-19, 24-31, 38-44, 46-57, drawn to processes for making oxcarbazepine, classified in class 264, subclass 109.
- III. Claims 58-67, drawn to a pharmaceutical composition, classified in class 424, subclass 464.

The Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, Claims 1-4, 7, 11-15, 20-23, 32-37, 45, and 68-72. Applicants reserve the right to file a divisional application directed to the non-elected subject matter of the other groups.

This election is made with traverse because it is believed that the claims can be regrouped into a single group. As the Examiner is aware, there are two criteria for a restriction requirement: (A) the inventions must be independent or distinct as claimed; AND (B) there must be a serious burden on the Examiner. "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct invention." MPEP §803

The Applicants believe that regrouping of the claims as a single group would not place an undue burden on the Examiner to search using the PTO's classification. The Applicants respectfully disagree with the Examiner that three different classes of searches are required. In regard to class 264, the class is entitled: "Plastic and nonmetal article shaping or treating processes." The Applicants do not know how this class is of any relevance since crystalline forms do not seem to be plastic nor an article. The class and subclass seem to apply to entirely different arts. In regard to class 424, the Applicants believe that after searching class 514, subclass 217, the Examiner does not need to carry out additional searches in class 424. Class 514, subclass 217 would probably be comprehensive in finding art related to all aspects of oxcarbazepine.

Applicants respectfully request that all of the claims be examined together since all the claims of the present application seem to be in the same class and subclass, and a serious burden would not be put upon the Examiner.

Applicants believe that regrouping the claims in the suggested manner will expedite prosecution.

## CONCLUSION

If there are any issues outstanding after consideration of this election, the Examiner is invited to contact the undersigned to expedite prosecution of this case.

Respectfully submitted,

KENYON & KENYON

Dated: Oct 9, 03

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